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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,548	07/23/2001	John G. Kenny	PLI-888	3475

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EXAMINER	
NASH, LASHANYA RENEE	
ART UNIT	**PAPER NUMBER**
2153	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/910,548	KENNY ET AL.	
	Examiner	Art Unit	
	LaShanya R Nash	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-13 and 18-20* is/are rejected.

7)☒ Claim(s) *10 and 14-17* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 are pending.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claims 1,8, and 10 are objected to because of the following informality: improper grammar. Appropriate correction is required.

Claims 1 and 8 recite, “a remotely-located users”. Examiner suggests amending the claims to recite, “a remotely-located user” for proper correction.

Claim 10 recites, “remotely-located user are”. Examiner suggests amending the claim to recite, “remotely-located user is” for proper correction.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2,4-9,11-13, and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 6,11, and 19 contain the service mark name Globalink Access. Where a trademark or trade name, which is also inclusive of a service mark, is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the type of Internet Service Provider and, accordingly, the identification/description is indefinite. For purposes of prior art rejections, the limitation of the aforementioned claim is interpreted in the broadest reasonable sense as "internet service provider is accessed by a specified address."

Claims 4 and 8 recite the limitation "and/or" on lines 19 and 39, respectively. The limitations can be interpreted in several contradicting ways, therefore rendering the claims indefinite.

Claims 6 and 11 recite the phrase "for example" in line 17 of each claim. This phrase renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 5 recites the limitations " a second local area network (LAN) " in lines 3,8-9, and 28-29. Also, the claim recites the limitation "a second server" in lines 8 and 11. There is insufficient antecedent basis for these limitations in the claim because a first LAN or a first server is not stated in the preceding claims (1-3). The examiner suggests amending the claim to recite the limitation "a local area network (LAN)" and "a server", respectively.

Claims 6 and 11 recite the phrase "etc." in lines 10,14,and 33 of each claim. This phrase renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "etc."), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d). Examiner suggests eliminating the phrase from the claim language.

Claims 7 and 12 recite the phrase "etc." in line 5 of each claim. This phrase renders the claim indefinite because the claim include elements not actually disclosed (those encompassed by "etc."), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Examiner suggests eliminating the phrase from the claim language.

Claims 9 and 18, contain the trademark Unix. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the type of operating system and, accordingly, the identification/description is indefinite.

Claim 13, contains the trademark Windows NT. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name

cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the type of operating system and, accordingly, the identification/description is indefinite.

Regarding claim 20, the phrase "optional" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Examiner suggests amending the claim to recite "at least one of the following", as opposed to optional.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by White (US Patent Application Publication 2001/0047418), hereinafter referred to as White.

In reference to claim 1, White discloses a local area networking system to provide Internet access to multiple shareable locations (e.g. hotel rooms) via the pre-existing telephone wiring (paragraph [0013], lines 1-4;and paragraph [0014], lines 1-6). White discloses:

- A multi-task, multi-location networking system (Figure 1) adapted to operate in combination with an Internet Service Provider (Figure 1-item 7) to process data requested by a remotely-located user (i.e. shareable location), the system comprising, (paragraph [0021], lines 1-12; paragraph [0015], lines 1-7; and Figure 1):
    - A central data-processing subsystem (Figure 4) having means for receiving, processing, and transmitting requested data, via the Internet Service Provider, (paragraph [0022], lines 1-13; paragraph [0023], lines 17-21; and paragraph [0028], lines 1-7; and paragraph [0025], lines 10-17); and
    - A remote data-processing subsystem (Figure 3) having means for allowing the remotely located user to access the requested data which is viewed on a computer terminal (i.e. shareable terminal), (paragraph [0021], lines 1-4;paragraph [0022], lines 1-13; and paragraph [0025], lines 1-17);

- A software program adapted to operate the central data-processing subsystem and the remote data-processing subsystem, (paragraph [0023], lines 1-12 and paragraph [0023], lines 7-12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over White as applied to claim 1 above, in further view of Moen et al. (US Patent 5,864,604), hereinafter referred to as Moen.

In reference to claim 2, although White discloses the aforementioned system communicates with an Internet Service Provider (paragraph [0022], lines 11-13 and Figure 1-item 7), the reference fails to explicitly disclose accessing the ISP via a site address. Nonetheless, accessing the Internet Service Provider via an address was well in the art at the time of the invention, as further evidenced by Moen. Therefore, this modification to the system as disclosed by White would have been obvious to one of ordinary skill in the art at the time of the invention.

In an analogous art, Moen discloses a telecommunications system for providing messaging service to a plurality of users via Internet Service Providers

(ISP), (column 2, lines 62-65 and column 4, lines 4-13). Moen further discloses that the ISP can be accessed by a specified Internet site address (column 5, lines 26-30). One of ordinary skill in the art would have been motivated to implement this modification to the aforementioned system in order to provide messaging services to the plurality of users of the shareable terminals, (Moen column 3, lines 19-29).

In reference to claim 3, the references show the Internet access system wherein the remotely located user is located in a hotel room wherefrom the requested data is accessed and viewed on the computer terminal (i.e. shareable terminal), (paragraph [0024], lines 1-4; paragraph [0025], lines 1-17; Figures 2-3).

Allowable Subject Matter

Claims 5-7,9,11,12,13, and 18-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. Subsequently, the dependent claims 14-17 are objected to by virtue of their dependency, but would be allowable upon overcoming the aforementioned rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (703) 305-8910. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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